

AMENDMENTS TO THE DRAWINGS

The attached sheet of drawings includes changes to Fig. 9. This sheet replaces the original sheet including Fig. 9. In Figure 9, previously omitted reference number 305 has been added.

Attachment: Replacement Sheet

REMARKS

The present application includes pending claims 1-28, all of which have been rejected. Reconsideration of the claim rejections is requested.

I. Drawings and Specification

The drawings were objected to under 37 CFR 1.83(a) because they allegedly do not show each simplex power receptacle having a respective housing and the specification was objected to for not including a reference numeral after the word "housing" that corresponds to a numeral in Fig 9 indicating the housing. Figure 9 has been amended to show reference numeral "305" indicating the housing of a power receptacle and the specification has been amended to add reference numeral "305" after the word "housing" to correspond with amended Figure 9, as suggested by the Examiner. Applicants respectfully submit that no new matter has been added, and that the amended drawings and specification overcome the Examiner's objections.

II. The Rejection Of Claims 1-28 Under 35 U.S.C. 103

Claims 1-28 were rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,417,446 ("Whitehead") in view of United States Patent No. 4,952,163 ("Dola"). The Applicants respectfully traverse this rejection, at least for the reasons set forth below.

A. The Combination of Whitehead and Dola Does Not Teach, Nor Suggest, All The Limitations of Claims 6-13, 15, 16-20, and 26-28

The combination of Whitehead and Dola does not teach, nor suggest, all the limitations of claims 6-13, 15, 16-20, and 26-28. Whitehead discloses a poke-through device for installation in a hole extending through a concrete floor structure of a building.

The device provides a four-plug arrangement, together with two data connection jacks, all located in a concealed manner. Whitehead at Abstract. Dola discloses a raceway assembly employing snap-on outlet covers. The raceway has multiple compartments extending longitudinally for carrying conductors such as standard house wiring power conductors and telephone or data conductors. Separate outlet housings each comprise a one piece bracket having a front wall on a parallel back wall. The brackets have openings in the front wall and outlet conductors, such as duplex receptacles or modular telephone jacks. Dola at Abstract.

With respect to claims 6-13, 18-20, and 26, neither Whitehead, nor Dola, teaches or suggests a fitting or insert that includes four simplex power receptacles **and** four communication/data jacks. Whitehead discloses a fitting having 1) **two** separate wedge-shaped receptacles 98 and 99 each carrying two outlets, and 2) **two** data jacks. Whitehead at column 6, line 63 to column 7, line 6. Additionally, Whitehead discloses, **in the alternative**, a fitting having 1) only a **single** receptacle 99, and 2) four data jacks with two of the data jacks in the region formerly occupied by the second receptacle 98. Whitehead at 7:67-8:11. Therefore, Whitehead does not teach, nor suggest, a fitting including both four receptacles and four jacks, and in fact teaches away from including four receptacles and four jacks because as, Whitehead acknowledges, “the maximum size of the interfloor is limited by building code requirements.” Whitehead at 4:65-5:3. Furthermore, Dola does not teach, nor suggest, a fitting including four power receptacles and four communication jacks. Because the combination of Whitehead and Dola does not teach, nor suggest, “four separately formed simplex power receptacles”

and “four communication/data jacks” as recited in claims 6-13, 18-20, and 26, claims 6-13, 18-20, and 26 are patentable over Whitehead in view of Dola, at least for this reason.

With respect to claims 16-17 and 27-28, neither Whitehead, nor Dola, teaches or suggests the fitting having four communication/data jacks being arranged in a longitudinal row, first and second receptacles disposed on a first lateral side of the communication/data jacks, and third and fourth receptacles disposed on a second lateral side of the communication jack. Again, Whitehead does not even disclose a fitting that can carry both four communication jacks and four receptacles, let alone four communication jacks in one longitudinal row with two receptacles on each side of the row. As shown in Figure 6, the embodiment from Whitehead that discloses a fitting carrying four communication jacks 126 and 127 clearly does not carry the four jacks arranged **in a single longitudinal row**. Also, as Figure 6 shows, when the fitting of Whitehead is configured to carry four jacks, the fitting can only carry one receptacle 99 on one side of the jacks. Whitehead does not disclose the fitting carrying two receptacles on a first lateral side of the jacks 126 and 127 and two receptacles on a second lateral side of the jacks 126 and 127. Furthermore, Dola does not teach, nor suggest, the fitting having four communication/data jacks being arranged in a longitudinal row, first and second receptacles disposed on a first lateral side of the communication/data jacks, and third and fourth receptacles disposed on a second lateral side of the communication/data jack. Because the combination of Whitehead and Dola does not teach, nor suggest, “four . . . communication/data jacks being

arranged in a longitudinal row” with the “first and second simplex . . . receptacles . . . on a first lateral side” of the communication/data jack[s and the “third and fourth simplex receptacles . . . on a second lateral side” of the communication data jacks, as recited in claims 16-17 and 27-28, claims 16-17 and 27-28 are patentable over Whitehead in view of Dola, at least for this reason.

With respect to claims 12, 15, and 19, neither Whitehead, nor Dola, teaches or suggests a fire stopping material disposed in the fitting “so that the fire rating of the floor, with the floor opening formed in the floor and with the poke-through wiring fitting supported in the floor opening, is substantially the same as the fire rating of the floor without the floor opening formed in the floor.” The Examiner asserts that this limitation can be found in Fig. 2 of Whitehead; however, Fig. 2 in no way indicates that the fire rating of the floor is substantially the same as the fire rating of the floor without the floor opening formed in the floor. Furthermore, Dora does not disclose this limitation either. Because the combination of Whitehead and Dola does not teach, nor suggest, a fire stopping material disposed in the fitting “so that the fire rating of the floor, with the floor opening formed in the floor and with the poke-through wiring fitting supported in the floor opening, is substantially the same as the fire rating of the floor without the floor opening formed in the floor,” as recited in claims 12, 15, and 19, claims 12, 15, and 19 are patentable over Whitehead in view of Dola, at least for this reason.

B. There Is No Motivation To Combine Whitehead With Dola

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (MPEP) states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art.

See MPEP MPEP § 2142. Additionally, if a *prima facie* case of obviousness is not established, the Applicants are under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See *id.*

1. Whitehead Relates To A Poke-Through Device

Whitehead discloses a “poke-through device for installation in a hole extending through a concrete floor structure of a building.” See Whitehead. Whitehead discusses that the size of a poke-through device is limited by the floor opening into which it is positioned.

[P]roblems still remain with the use of poke-through devices. Once such problem involves the **limited number of electrical interfaces** provided by the prior art devices. It will be recognized that the size of the hole which may be drilled

through a concrete floor is limited by the structural characteristics of the floor. Typically, **building codes allow the drilling of a hole having a diameter between about two and four inches, which thus limits the maximum size of the poke-through device.** However, even utilizing the mentioned four inch diameter hole, prior art devices only provide a **limited number of electrical interfaces.** For example, a single prior art poke-through device typically provides only a two-plug arrangement.

Whitehead at column 1, lines 50-62 (emphasis added). *See also id.* at column 4, line 65 to column 5, line 3 ("Inasmuch as floor structure 14 is typically a structural, load bearing member of the building, the maximum size of the interfloor is **limited by building code requirements.** In particular, interfloor holes, typically range in diameter from two to four inches.").

Whitehead clearly recognizes the difficulties of trying to maximize electrical applications on the limited area of a poke-through, the size of which is dictated by a corresponding floor opening. As such, Whitehead discloses specific designs intended to maximize such capabilities. In particular, Whitehead discloses the following:

The device provides a four-plug arrangement, together with two data connection jacks, all located in a concealed manner. The device alternatively provides a two-plug arrangement, together with four data connection jacks. An additional alternative embodiment provides an arrangement having six data connection jacks.

Whitehead at Abstract. Notably, Whitehead only discloses those three embodiments. In short, Whitehead's embodiments attempt to maximize use of the limited space on a poke-through by the three disclosed embodiments. Introducing additional bulky or even optional materials into the limited space of Whitehead's poke-throughs, however, would increase their sizes, thereby precluding them from being used in constrained spaces (*e.g.*, four inch holes, which are mandated by building codes, as noted above).

To maximize the space on a poke-through surface, Whitehead discloses specific embodiments that allow for three different arrangements, as noted above in the Abstract of Whitehead. In particular, Whitehead discloses specific wedge-shaped electrical duplexes, or, alternatively, a bow-tie configuration.

As shown, the receptacles are preferably formed as separate wedge-shaped units, each including two electrical outlets. The electrical outlets, *i.e.*, outlets 114, are configured for receipt of conventional 110 voltage electrical plugs. Of course, the outlets may be configured for receipt of various other electrical plugs. Alternatively, the receptacle may be formed as a single "bow-tie" shaped four-plug unit (receptacle 98').

Id. at column 6, line 63 to column 7, line 3. In an effort to maximize the space on the poke-through, Whitehead only discloses the use of the specific wedge-shaped duplex receptacles, or the bow-tie quad receptacle. Adding or substituting other receptacles would add size to Whitehead's poke-through, and therefore make it unusable for its intended purpose. With that in mind, the Applicants now turn to Dola.

2. Dola Cannot Be Combined With Whitehead

Initially, the Applicants note that a “prior art reference **must** be considered in its **entirety**, *i.e.*, as a whole, including portions that would lead away from the claimed invention.” MPEP at 2141.02.

Dola relates to a “raceway assembly employing snap-on outlet covers.” See Dola at Abstract. “The raceway has multiple compartments extending longitudinally for carrying conductors such as standard house wiring power conductors and telephone or data conductors.” *Id.*

This invention relates to a raceway assembly which can be employed with power conductors and telephone or data conductors and can be mounted **either inlaid in a wall or along the surface of a wall or panel**. More particularly, this invention relates to a outlet or a receptacle housing which can be employed with a raceway containing a plurality of compartments, each compartment containing a unique set of wires, such as power, telephone or data conductors.

Id. at column 1, lines 9-17 (emphasis added). Dola relates to a raceway assembly that may be mounted or secured within or on walls. The raceways may extend over long distances. In general, the raceways disclosed in Dola are not restricted by the same space constraints as the poke-through device disclosed in Whitehead. As such, the raceways in Dola may utilize additional and bulkier components than the three embodiments disclosed in Whitehead.

As noted above, Whitehead discloses specific wedge-shaped duplexes or bow-tie quads to maximize the limited space within the poke-through. Picking and choosing an isolated element from Dola and attempting to shoehorn into the poke-through device

disclosed in Whitehead, however, would add size and bulk to the poke-through device, thereby making it too large to adequately mount into a floor opening.

“In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is **not** whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP at 2141.02. The law is well settled that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so.” *ACS Hospital Systems, Inc. v. Montfiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984). It is not permissible to pick and choose among the individual elements of assorted prior art references to re-create the claimed invention, but rather “some teaching or suggestion in the references to support their use in the particular claimed combination” is needed. *Symbol Technologies, Inc. v. Opticon, Inc.* 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991).

To summarize, adding Dola to Whitehead ignores the references as a whole. There simply is no teaching or suggestion in Whitehead to use any of the bulky components from Dola, which is not concerned with the space-constraining considerations of Whitehead. As such, the Applicants respectfully submit that there is no motivation or suggestion to combine Whitehead with Dola.

3. The Office Action Merely Picks And Chooses Isolated Elements From Disparate References

The Applicants respectfully submit that attempting to pick and choose single isolated elements from Dola and shoehorn them into Whitehead ignores the references in

their entireties and is therefore improper. There simply is no suggestion in these references to combine them to arrive at the invention recited in the claims of the present application. Even if one assumed that the combination did teach the limitations recited in the claims, there simply is no motivation to combine these references.

In *Ex parte Hiyamazi*, the Board of Patent Appeals and Interferences reversed a rejection based on a combination of references, stating, in part:

Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the reference viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). **It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious.** That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

Ex parte Hiyamazi, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Interf. 1988) (emphasis added).

The Examiner argues that a motivation to combine Whitehead with Dola can be found where Whitehead states the “present invention allows the device to be readily modified to meet various requirements.” Whitehead at 7:62-63. However, this vague boilerplate statement certainly does not qualify as “a convincing line of reasoning suggesting the desirability of combining” the spatially-limited fitting of Whitehead with

the large, unconstrained raceway assembly of Dola to arrive at the inventions of the pending claims.

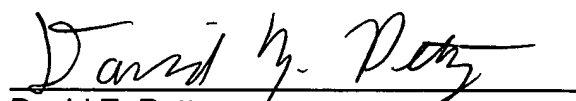
In combining Whitehead and Dola, the Office Action has merely picked and chosen among isolated, individual elements of separate references to re-create the Applicants' claimed invention. There is no teaching or suggestion in these references to support their use in the particular claimed combination. The proposed combination represents "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed.Cir. 1983). Thus, at least for these reasons, the Applicants respectfully submit that the claims of the present application should be in condition for allowance.

III. Conclusion

In view of the above, claims 1-28 are believed to be in condition for allowance. The Examiner is invited to telephone the Applicants' undersigned attorney at (312) 775-8000 if any unresolved matters remain. Please charge any fees due in connection with this submission to Deposit Account No. 13-0017.

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Respectfully submitted,


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